

### **REMARKS**

The Examiner and Supervisory Examiner Thomas are thanked for the interview conducted on January 10, 2006 and for accommodating the undersigned's schedule. The Applicant has carefully reviewed the suggestions made by the Examiners in the interview and these suggestions are reflected in the foregoing claim amendments. In particular, this Amendment amends independent claims 1, 5, 26, and 32 to further distinguish over the cited references. A typographical error was also corrected in the foregoing amendments in independent claim 32.

In the September 15, 2006 Office Action, claims 1-32 stand rejected under 35 USC § 101 for allegedly claiming non-statutory subject matter. Claims 1-32 also stand rejected under 35 USC § 103(a) for obviousness over United States Patent No. 5,950,169 to Borghesi et al. ("Borghesi") in view of a "PR Newswire" article dated March 21, 2001 ("PR Newswire"). In view of the foregoing amendments and following remarks, the Applicants respectfully request reconsideration of all of the Examiner's rejections.

Initially, reconsideration and removal of Examiner's rejections under 35 USC § 101 are requested in view of the precedential opinion, *In re Lundgren*, recently issued by the Board of Patent Appeals and Interferences. Pursuant to the interview conducted earlier this month, the Applicants are of the understanding that these rejections will be withdrawn based on the pronouncements in *In re Lundgren*.

With respect to the respective obviousness rejections of independent claims 1, 15, 26, and 32, independent claim 1 is generally representative of rejected independent claims 1, 15, 26, and 32. Independent claim 1 is directed to a method of processing vehicle damage claims, comprising the steps of: reporting a vehicle damage claim to an insurance provider by a claimant; delivering a damaged claimant vehicle to an insurer facility operated by the insurance provider; preparing a repair estimate at the insurer facility by a representative of the insurance provider; selecting a repair facility, with the repair facility selected by the insurance provider; repairing the damaged claimant vehicle at the repair facility; returning the repaired claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant. As amended, independent claim 1 now further sets forth that the step of selecting a repair facility is conducted by the insurance provider without input from the claimant.

Additionally, the method step of returning a repaired claimant vehicle to the insurer facility is further described as being conducted without input from the claimant. Similar amendments were made to independent claims 15 and 26. Moreover, similar claim amendments were made to independent claim 32. However, the term "customer" is used in place of the word "claimant" in independent claim 32. The clarifying language added to the independent claims more distinctly indicates that the step of selecting a repair facility is done actively by the insurance provider and, thus, without input from the claimant/customer. This clarifying language is believed to further distinguish independent claims 1, 15, 26, and 32 over the cited references.

As indicated, independent claim 1, 15, 26, and 32 stand rejected over Borghesi in view of PR Newswire. With respect to the specifics of the obviousness rejections, in paragraph 5, page 4 of the Office Action the Examiner points to column 9, lines 18-42 of Borghesi for the alleged teaching of a method step of "selecting a repair facility, with the repair facility selected by the insurance provider". The Examiner then states that Borghesi does not explicitly disclose that the claimed method steps of returning the repaired claimant vehicle to the insurer facility and returning the repaired claimant vehicle to the claimant as set forth in independent claim 1. Similar rejections are made against the specific language used in independent claims 15, 26, and 32. Accordingly, Applicants comments hereinafter relating to Borghesi and PR Newswire, while made in connection with the specific language used in independent claim 1, are also applicable to the requirements set forth in independent claims 15, 26, and 32.

Borghesi is discussed in the background section of the application and discloses a system and method for managing insurance claims that includes a computer network. The computer network controls the electronic transmission of files between various computers. Computers may be located at disparate locations including parts supply vendors, repair shops, salvage yards, insurance company offices, and other locations that may be involved in an insurance claim processing situation. When a claim is filed, the claim is entered as a work file in the system. The different computers in the network may access the work file to enter certain information in the work file which is then accessible by all the computers of the network. For example, a repair shop may be entered into the work file for cost estimates, both labor and parts, for repairing a particular vehicle. The work file may also

contain vehicle information describing the vehicle, identification number, year, make, model, and other pertinent information about the vehicle.

In the passage pointed to by the Examiner in Borghesi, it is merely indicated that one of the pieces of information contained in the computer network is the repair site at which the damaged vehicle is being repaired. Accordingly, Borghesi does not teach or suggest a method step of an insurance provider selecting a repair facility without input from the claimant/customer, as set forth in independent claim 1. As indicated previously, independent claims 15, 26, and 32 include analogous method steps to the foregoing repair facility selection step and Borghesi fails to teach or suggest these analogous method steps set forth in independent claims 15, 26, and 32. Borghesi, at best, teaches that the computer network contains the location of the repair facility but does not discuss how this repair facility is selected.

With respect to the PR Newswire reference cited by the Examiner, this document fails to overcome the foregoing deficiencies of Borghesi. In paragraph 7 of PR Newswire, it is stated that the website, *progressive.com*, includes a repair facility locator service. Clearly, this on-line service is provided to give the claimant/customer the ability to shop for repair facilities for a damaged vehicle. Additionally, it is equally clear from the text in paragraph 7 of PR Newswire, that this paragraph does not include a teaching or suggestion of having the insurance provider select a repair facility for repair of the damaged claimant/customer vehicle. In actuality, as the website is accessed by the claimant/customer to shop for a repair facility, this repair facility locator service necessarily requires the input of the claimant/customer which is contrary to the language in amended independent claim 1 and, thus, generally contrary to the language in amended independent claims 15, 26, and 32. Providing such a repair facility locator service on the website in actuality teaches away from the claim language in independent claim 1 wherein the repair facility is selected by the insurance provider.

In summary, the two instances indicated by the Examiner where a “repair facility/service” is mentioned in the two cited references fail to teach or suggest in any way having an insurance provider select a repair facility without input from the claimant/customer. In Borghesi, the disclosed computer network merely indicates that the location of a repair facility may be accessed by a computer in the network. In the PR

Newsire document, the *progressive.com* website merely provides a repair facility locator service specifically for use by the claimant/customer without input from the insurance provider which is essentially opposite to the requirements of independent claim 1. Furthermore, each cited reference is completely silent with respect to the claimed method step of returning the repaired claimant vehicle to the insurer facility without input from the claimant as further required by amended independent claim 1. No such method step is remotely present in either cited reference, and independent claim 1 further distinguishes over the cited references for this additional reason.

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of rejected claims 1-32. Further, Applicants respectfully examination and allowance of claims 33-42 appropriately added by Preliminary Amendment on August 8, 2005. Accordingly, in view of the lack of examination of claims 33-42, any further Office Actions in this application should not be made final.

If the Examiner wishes to discuss the foregoing claim amendments and cited references further, he is invited to contact the undersigned at the telephone number provided.

Respectfully submitted,

THE WEBB LAW FIRM

By



Ryan J. Miller  
Registration No. 56,236  
Agent for Applicants  
700 Koppers Building  
436 Seventh Avenue  
Pittsburgh, Pennsylvania 15219-1845  
Telephone: 412-471-8815  
Facsimile: 412-471-4094  
E-mail: webblaw@webblaw.com